



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/623,424	07/18/2003	Robert J. Vidal	VER.001.P	4082

26990 7590 05/22/2006

DAVID B. WALLER & ASSOCIATES
5677 OBERLIN DRIVE
SUITE 214
SAN DIEGO, CA 92121

EXAMINER

WILLIAMS, JAMILA O

ART UNIT	PAPER NUMBER
----------	--------------

3722

DATE MAILED: 05/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

6

Office Action Summary	Application No. 10/623,424	Applicant(s) VIDAL, ROBERT J.	
	Examiner Jamila O. Williams	Art Unit 3722	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 20 is/are allowed.
- 6) ☒ Claim(s) 1-5, 7-10 and 12-19 is/are rejected.
- 7) ☒ Claim(s) 6, 11 and 21 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|----------------------------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>11/3/2003</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

Upon further consideration the restriction requirement mailed 11/16/2005 has been withdrawn. Therefore all claims (1-21) are being treated on the merits.

Drawings

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the shapes recited in claim 2; the form tube, recited in claim 6; the magnet, recited in claims 8 and 14; the lighting means, recited in claim 16 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner,

the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Objections

In claim 21 line 11, "treaded" should read --threaded--. Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 10,12,13,14,17,18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claims 12-13 and 14 there is a lack of antecedent basis for "said guide". In claims 17-18 there is a lack of antecedent basis for "said lighting means". The multiple lack of antecedent basis issues in these claims makes the breath of the claims unclear.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3,7,19 are rejected under 35 U.S.C. 102(b) as being anticipated by 2,339,324 to Fischer. Fischer discloses a protective shield (fig 3) comprising a cylindrical shaped housing having a front and back end, the front end able to fit flush against a working surface (fig 4) and a spring (48) having a first and second end, the first end able to receive the back end of the cylindrical shaped housing and the second end able to receive a drilling or cutting tool chuck (fig 3 and fig 4), the housing able to receive debris from the drilling or cutting tool operation, as recited in claim 1.

Regarding claims 2-3, Fischer discloses that the cylindrical shaped housing is conical cylinder shaped (fig 3) and the housing is cup shaped (fig 3).

Regarding claim 7, Fischer discloses that the protective shield further comprises a chamber formed between the drilling or cutting tool chuck and the cylindrical shaped housing near the back end to receive debris from the drilling cutting tool (see figure 4 the area between the drill chuck and front of the housing defines a chamber, this area receives debris prior to it being carried to the dust bag via hose 36- see page 3 lines 30-41 of the specification).

Regarding claim 19, Fischer discloses a method of preventing injury from debris resulting from the operation of a drill or cutting tool comprising the steps of affixing a protective shield onto the drilling or cutting tool having the features recited in claim 1 (above) and operating the drilling or cutting tool (figs 3-5).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fischer in view of 3,936,213 to Kappel. Fischer discloses all of the elements of the claims as applied to claim 1 above. Fischer does not however disclose that the housing is made of durable heat resistant and impact resistant material

Kappel teaches having a collector for debris wherein the housing is made of plastic (col3 lines 15-17). It would have been obvious to one having ordinary skill in the art at the time the invention was made to use the material teaching of Kappel with the housing of Fischer for the purpose of making the device more durable.

Claims 5 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fischer in view of 3,583,821 to Shaub et al (hereinafter Shaub). Fischer discloses all of the elements of the claims as applied to claim 1 above. Fischer does not however disclose having a housing that is transparent or a slide means to protect the working surface from damage. Shaub teaches having a transparent housing (col 2 line 35 of the specification) and a slide means (8, rubber ring). It would have been obvious to one having ordinary skill in the art at the time the invention was made to use the slide means of Shaub with the device of Fischer for the purpose of protecting the work surface.

Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fischer in view of 6,276,878 to Lee. Fischer discloses all of the elements of the claims as applied to claim 1 above. Fischer does not however disclose having a magnet in the housing. Lee teaches having a tool with a magnet (15b) therein. It would have been obvious to

one having ordinary skill in the art at the time the invention was made to use the magnet of Lee with the housing of Fischer for the purpose of adding in the removal of metal debris or chips during the cutting operation.

Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fischer in view of 5,152,327 to Shoda. Fischer discloses all of the elements of the claims as applied to claim 1 above. Fischer does not however disclose having bristle fibers along the front end of the housing. Shoda teaches having brushes (18) along the front of the housing. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use the brushes of Shoda with the device of Fischer for the purpose of protecting the work surface.

Claims 16-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fischer in view of 5,522,683 to Kakimoto et al (hereinafter Kakimoto). Fischer discloses all of the elements of the claims as applied to claim 1 above. Fischer does not however disclose having a lighting means to illuminate the work surface; the lighting means comprising a light source, switch and power supply. Kakimoto discloses a device having a lighting means (1) comprising a light source (LED 9), switch and power supply (fig 5). It would have been obvious to one having ordinary skill in the art at the time the invention was made to use the lighting means of Kakimoto with the device of Fischer for the purpose of illuminating the work surface.

Allowable Subject Matter

Claims 6,11, 21 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 10,12, 13,14, and 18 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Claim 20 is allowed over the prior art.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. This is simply art of interest and was not used to reject any claims in this office action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jamila O. Williams whose telephone number is 571-272-4431. The examiner can normally be reached on Monday-Friday 6:30am-3:00pm.

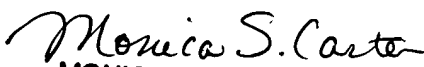
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Monica Carter can be reached on 571-272-3484. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3722

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



JW 5/2/2006


MONICA CARTER
SUPERVISORY PATENT EXAMINER